

REMARKS

Claims 1-37 are currently pending in the subject Application.

Claims 1-11, 13-21, 23-34, 36, and 37 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,991,739 to Cupps, et al. ("*Cupps*") in view of U.S. Patent No. 4,971,406 to Hanson ("*Hanson*") and U.S. Patent No. 5,895,454 to Harrington ("*Harrington*").

Claims 12, 22, and 35 stand rejected under 35 U.S.C. § 103(a) over *Cupps* in view of *Hanson* and *Harrington*, and further in view of U.S. Patent No. 4,797,818 to Cotter ("*Cotter*").

Applicant respectfully submits that all of Applicant's arguments and amendments are without *prejudice* or *disclaimer*. In addition, Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicant further respectfully submits that by not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are considered sufficient to overcome the Examiner's rejections. In addition, Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

As discussed in detail below, Applicant respectfully submits that each pending claim, as amended, is in condition for allowance and request that the rejections under 35 U.S.C. § 103 be withdrawn.

I. ART REJECTIONS

A. 35 U.S.C. § 103(a) over Cupps in view of Hanson in further view of Harrington

Pending Claims 1-11, 13-21, 23-34, 36, and 37 stand rejected under 35 U.S.C. § 103(a) over *Cupps* in view of *Hanson* and *Harrington*.

In rejecting Claims 1-11, 13-21, 23-34, 36, and 37 under 35 U.S.C. § 103(a) over *Cupps* in view of *Hanson* further in view of *Harrington*, the Examiner states:

Cupps discloses the general concept of brokering food orders over the Internet wherein a plurality of buyers have access to a database of a plurality of unaffiliated restaurants that deliver food (Fig. 1 and 7). Each of the buyers inputs their location and the broker displays restaurants that deliver to that location and indicates specials (Fig. 8). Each of the restaurants displays a menu of available food items and price (Fig. 9), any one of which may be considered “special.” Once an item is found, the buyer initiates a transaction and is given a response or confirmation from the restaurant which includes a delivery time (column 11, line 26-27). The delivery time is real time and inherently would include any backlog on the part of the seller since the seller is the one providing the delivery time (column 11, line 11-12). Cupps does not disclose the real time delivery time being provided prior to a selection being made by the customer. Hanson discloses a food order and delivery system wherein the real time delivery time, based at least in part on actual deliveries, is communicated to the customer as a transaction is being made (column 16, line 64-68) so the customer can take that into account prior to placing an order. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to communicate the real time delivery time to the customer in Cupps prior to the order being placed so that the customer could make a more informed decision. Modified Cupps does not disclose the real time delivery time communicated to the customer prior to a transaction being initiated. Harrington discloses a system using the internet where in addition to other criteria such as price etc...the delivery time is included to the customer in a hierarchical scheme, in other words rank, from a plurality of sellers for comparison to the customer so that a determination on purchasing an item can be based on the delivery time (column 5, lines 25-61) and teaches to include a maximum delivery time preference (column 5, line 26-27). Harrington further teaches to provide alternatives to the customer if the criteria is not met (column 6, lines 4-9). At the time the invention was made, it would have been obvious of the person of ordinary skill in the art to

communicate the real time delivery time to the customer in modified Cupps in a manner as disclosed in Harrington so that delivery time could be used by the customer as criteria for determining which food item to order before beginning any transaction.

Applicant respectfully submits that *Cupps* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding a *food order transaction broker* that utilizes “**buyer delivery information** associated with each of a plurality of buyers, the buyer delivery information compris[ing] information selected from the group consisting of a **maximum delivery time preference of at least one of the plurality of buyers** and an **indication of how important the delivery time is** to the at least one of the plurality of buyers.” Figure 1 of *Cupps* on which the Examiner relies, merely discloses, “an online ordering machine...in communication with one or more vendors...through one or more telephone links.” (See Column 3, lines 54-56) Nowhere does *Cupps* disclose the use of “buyer delivery information associated with each...buyer, [the] maximum delivery time preference of...[the] buyer, [or] an indication of how important the delivery time is to the...buyer” but merely teaches a traditional online ordering system that allows buyers to place an order with a vendor.

The disclosure of *Hanson* on which the Examiner relies also does not in fact teach real time delivery time being provided prior to a selection being made by the customer. Rather, *Hanson* states at column 16, lines 64-68:

[W]hen the identification card is inserted in a receiving device at the checkout station, the checkout processor will record the driver's identity in relation to each assigned order to be delivered, and notify the central processor accordingly. The central processing system may estimate the delivery time required by each driver, and advise the order entry station if an **unusual delay in future deliveries** is to be expected so that customers can be advised accordingly.

The Examiner appears to equate advising customers of an “unusual delay” with “real time delivery time information” as recited in independent Claim 1. Applicant respectfully submits that merely providing information that there will be a delay beyond the normal expected delivery time does not constitute providing customers with real time delivery time

information because it does not provide a specific time estimate in real time as to when they may expect their order to be delivered. Also, the fact that the “order entry station” is the point at which customer notification of an “unusual delay in future deliveries” occurs suggests this notification does not occur **prior to** customers’ selection of a restaurant from a plurality of restaurants nor **prior to** placement of an order with the selected restaurant. Rather, this suggests that notification of an “unusual delay in future deliveries” occurs after the customer has already selected a particular restaurant and has placed an order therein. As a result, Applicant respectfully submits that *Hanson* does not teach the claimed limitation for which the Examiner has relied on this reference.

Further, the Examiner appears to rely on *Harrington* to teach the limitation of “generat[ing] a list of one or more of the plurality of unaffiliated sellers for at least one of the requested particular food items according to a **comparison** of the requested particular food item **with the real-time availability information** for each unaffiliated seller and a comparison of the buyer delivery information with the unaffiliated seller delivery information,” as recited by Applicant’s independent Claim 1. Applicant respectfully submits that *Harrington* does not in fact teach this limitation. Rather, *Harrington* discloses only that a user inputs delivery time criteria into the database interface. (See Column 5, lines 27-28). Nowhere does *Harrington* disclose performing “a **comparison** of the requested...item **with the real-time availability information** for each unaffiliated seller and a comparison of the buyer delivery information with the unaffiliated seller delivery information” as required by Applicant’s Claim 1.

As discussed in detail above, Applicant submits that *Cupps* does not teach the elements that the Examiner relies on this reference for. Neither *Hanson* nor *Harrington* provides the missing teachings. Because the references do not alone or in combination, describe each element of Claims 1-11, 13-21, 23-34, and 36-37, Applicant respectfully requests that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn.

B. 35 U.S.C. § 103(a) over *Cupps* in view of *Hanson* in further view of *Harrington* in further view of *Cotter*

In rejecting Claims 12, 22, and 35 under 35 U.S.C. § 103(a) over *Cupps* in view of *Hanson* further in view of *Harrington* further in view of *Cotter*, the Examiner states:

Cotter teaches the selection of a restaurant or seller for a delivery order automatically based on real time delivery (column 2, line 21-31). At the time the invention was made, it would have been obvious for one of ordinary skill in the art to provide for the automatic selection of a seller in a modified *Cupps* based on real time delivery time as disclosed in *Cotter* in order to save time to the customer.

However, neither *Cupps* nor *Cotter* whether taken together or separately disclose or suggest every element of Claims 12, 22, and 35. Claim 12, as amended, provides among other things:

wherein the broker is further operable to select one of the plurality of listed sellers automatically according to at least the ***real-time delivery time information*** for all of the plurality of listed unaffiliated sellers.

As discussed in detail above, *Cupps* does not disclose these elements. *Cotter* does not teach the missing elements. Rather, the column 2, lines 21-31 of *Cotter* on which the Examiner relies states:

Fig. 1 depicts a telephone center 10 located in a municipality or other region served by a number of related or franchised stores 12. The telephone center 10 houses operators that enter information into a computer system adapted to automatically assign incoming orders to the store best able to respond to those orders. Often, the assigned store will be the one nearest the customer's residence, however, ***local factors*** such as ***traffic patterns, time of day and road construction*** may dictate that a store other than the nearest one will provide optimum service.

As seen above, *Cotter* describes local factors that are considered when determining which store is best able to respond to an incoming order. *Cotter* does not, however, teach the use of “***real-time delivery information***” in selecting from a “***plurality of listed unaffiliated sellers***” as recited in Applicant's amended Claim 12. The factors relied upon in *Cotter* are merely predictions based on historical data and are not actually determined from real-time data. For example, the use of traffic patterns, time of day, and road construction as factors in determining which store is best able to handle the order relies on

past information about the flow of traffic, typical conditions at a certain time of day, and the assumption that road construction that began at some time in the past is still currently in progress. *Cotter* does not disclose or suggest that actual real-time data about current traffic flows or other conditions currently existing is collected and used in making a determination about which store the order will be sent to.

As discussed in detail above, Applicant respectfully submits that neither *Cupps*, *Hanson*, nor *Harrington* teach the elements that the Examiner relies on these references for. *Cotter* also does not provide the missing teachings. Because the references do not alone or in combination, describe each element of Claims 12, 22, and 35, Applicant respectfully requests that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn.

The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Cupps-Hanson-Harrington-Cotter* Combination According to the UPSTO Examination Guidelines

Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Cupps*, *Hanson*, *Harrington*, or *Cotter*, either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (the “Guidelines”).

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “**ensure that the written record includes findings of fact** concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “**factual findings made by Office personnel are the necessary underpinnings to establish obviousness.**” (*id.*). Further, “**Office personnel must provide an explanation to support an obviousness rejection** under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject application, the Office Action has not shown the **factual findings necessary to establish obviousness** or even **an explanation to support the obviousness rejection** based on the proposed combination of *Cupps*, *Hanson*, *Harrington*, and *Cotter*. The Office Action merely states that “it would have been obvious for one of ordinary skill in the art to communicate the real time delivery time to the customer in *Cupps* prior to the order being placed” and “it would have been obvious for the person of ordinary skill in the art to communicate the real time delivery time to the customer in modified *Cupps* in a manner disclosed in *Harrington*”. (16 January 2008 Office Action, Page 3). Applicant respectfully disagrees and respectfully submits that the Examiner’s conclusory statement is not sufficient to establish the **factual findings necessary to establish obviousness** and is not a sufficient **explanation to support the obviousness rejection** based on the proposed combination of *Cupps*, *Hanson*, *Harrington*, and *Cotter*.

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “**obviousness rejection should include**, either explicitly or implicitly in view of the prior art applied, **an indication of the level of ordinary skill.**” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided **an indication of the level of ordinary skill.**

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that **Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.** (*Id.*). In addition, the Guidelines state that the proper analysis is **whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.** (*Id.* and See 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicant’s invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to **explain why the difference(s) between the proposed combination of Cupps, Hanson, Harrington, Cotter, and Applicant’s claimed invention would have been obvious to one of ordinary skill in the art.** The Office Action merely states that “so that the customer could make a more informed decision” and “so that delivery time could be used by the customer as criteria for determining which food item to order before beginning any transactions.” (16 January 2008 Office Action, Page 3). Applicant respectfully disagrees and further respectfully requests clarification as to how this statement **explains why the difference(s) between the proposed combination of Cupps, Hanson, Harrington,**

Cotter, and Applicant's claimed invention would have been obvious to one of ordinary skill in the art. Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the “key to supporting any rejection under 35 U.S.C. 103 is the **clear articulation of the reason(s) why the claimed invention would have been obvious.**” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that “**the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.**” (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that “[R]ejections on **obviousness cannot be sustained by mere conclusory statements**; instead, there **must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.**” (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicant respectfully submits that the **Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicant's claimed invention would have been obvious.** For example, the **Examiner has not adequately**

supported the selection and combination of Cupps, Hanson, Harrington, and Cotter to render obvious Applicant's claimed invention. The Examiner's unsupported conclusory statements that "it would have been obvious for one of ordinary skill in the art to communicate the real time delivery time to the customer in Cupps prior to the order being placed", "it would have been obvious for the person of ordinary skill in the art to communicate the real time delivery time to the customer in modified Cupps in a manner disclosed in Harrington", "so that the customer could make a more informed decision", and "so that delivery time could be used by the customer as criteria for determining which food item to order before beginning any transactions", ***does not adequately provide clear articulation of the reasons why Applicant's claimed invention would have been obvious.*** (16 January 2008 Office Action, Page 3). In addition, the Examiner's unsupported conclusory statement fails to meet any of the Guidelines rationales to render obvious Applicant's claimed invention.

Thus, if the Examiner continues to maintain the obvious rejection based on the proposed combination of *Cupps, Hanson, Harrington, and Cotter*, ***Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including a statement by the Examiner identifying which one of the seven rationales the Examiner is relying on and the proper analysis of that particular rationale, as required by the Guidelines.***

Applicant's Claims are Patentable over the Proposed *Cupps-Hanson-Harrington-Cotter* Combination

As mentioned above, independent Claims 1, 13, 23, and 24 are considered patentably distinguishable over *Cupps, Hanson, Harrington, and Cotter*.

With respect to dependent Claims 2-12, 14-22, 25-35, 36, and 37: Claims 2-12 depend from independent Claim 1; Claims 14-22, 36, and 37 depend from independent Claim 13; and Claims 25-35 depend from independent Claim 24. As mentioned above, each of independent Claims 1, 13, 23, and 24 are considered patentably distinguishable over the proposed combination of *Cupps, Hanson, Harrington, and Cotter*. Thus,

dependent Claims 2-12, 14-22, 25-35, 36, and 37 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, Applicant respectfully submits that Claims 1-37 are not rendered obvious by the proposed combination of *Cupps*, *Hanson*, *Harrington*, and *Cotter*. Applicant further respectfully submits that Claims 1-37 are in condition for allowance. Thus, Applicant respectfully requests that the rejection of Claims 1-37 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-37 be allowed.

CONCLUSION

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

16 April 2008
Date

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